

13
(Amended)
-- 15. (Amended) The memory card of claim 10 wherein said data written to said storage device comprise a data file; and wherein said read status instruction signal is supplied prior to writing a data file to or erasing a data file from said storage device.

✓ Please cancel claim 12, without prejudice.

REMARKS

In light of the remarks to follow, reconsideration and allowance of this application are respectfully solicited.

Claims 18-40 are directed to a non-elected convention and are canceled, without prejudice to Applicants' right to re-submit claims 18-40 in a divisional application.

Claims 1 and 10 are amended. Claims 1-11 and 13-17 are presented for consideration. It is submitted that these claims, as originally presented, are patentably distinct over the prior art cited by the Examiner, and that these claims were in full compliance with the requirements of 35 USC 112. Changes to these claims, as presented herein, are not made for the purpose of patentability within the meaning of 35 USC sections 101, 102, 103 or 112. Rather, these changes are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

Claims 1-17 were rejected under 35 USC 112 as allegedly being indefinite because claims 1 and 10, the only independent claims, recite "a *substantially* rectangle or card body." The Examiner takes the position that the word "substantially" renders the claims indefinite "since it is unclear if the card is rectangular or not."

Reconsideration and withdrawal of this rejection are respectfully solicited. The Court of Appeals for the Federal Circuit has consistently permitted the use of the word "substantially" in

describing the shape of a claimed device. See York Products, Inc. v. Central Tractor Farm & Family Center, 40 U.S.P.Q.2d 1619 (Fed. Cir. 1996); Andrew Corp. v. Gabriel Electronics, Inc., 6 U.S.P.Q. 2d 2010 (Fed. Cir. 1988). It is submitted that, consistent with CAFC decisions, the word "substantially" as used in the claims of the present application does not render the claims indefinite. It is clear that the intent of the word "substantially" is to provide a reasonable flexibility to the words used to define Applicants' invention. A card body that is not precisely rectangular because, for example, its parallel edges may not be totally and completely parallel because of manufacturing tolerances, nevertheless should be covered by the claims.

Withdrawal of the rejection of the claims based upon 35 USC 112 is solicited.

Claim 1 was rejected as being obvious in view of the combination of U.S. Patents Nos. 5,016,086 (Inoue), 5,388,248 (Robinson), 5,925,928 (Hafner) and 6,145,023 (Iwasaki). Reconsideration and withdrawal of this rejection, as well as the prior art rejections of claims 2-9, are requested.

Claim 1 states that an electric switch is located on one of the surfaces of the card body, this switch being operable to prevent the data stored in the storage device in the card body from being erased. None of the references that have been applied against claim 1 suggests an electric switch located on a surface of the card body. Inoue describes terminals disposed in the card body and contacted by the insertion of a plug into the card body. This, of course, is quite different than having terminals disposed on the surface of the card body; and Inoue requires a far more accurate coupling plug than would be the case if the terminals were disposed on the surface of Inoue's body. Contrary to the Examiner's unsupported assertion, it is not an obvious matter of design to dispose Inoue's terminals on the surface of his card, as opposed to within the body itself. Inoue is designed for use with a particular plug that must be physically inserted into the

card body. The present invention permits a far easier coupling to the terminals by permitting a set of fingers to "float" into contact with the terminals, rather than inserting fingers into the card body which subjects those fingers to damage arising out of improper alignment between the plug and the card. Clearly, and with respect to the Examiner's conclusion, terminals in the card body, as in Inoue, do not function just as well as terminals on the surface of the card. Terminals on the surface solve a problem that cannot be met by terminals inside the card body: the problem of damage to a connecting plug and to the card terminals in the event that plug is not precisely aligned with the terminals in the card.

Inoue describes a switch in the front edge of his card body. This is quite different than locating the switch on the surface of the card. Because the switch of claim 1 is located on the surface, the switch can be disposed closer to the terminals and to the claimed control circuit. As a consequence, the connecting wires between the switch and the control circuit can be shortened and this not only minimizes electrical interference, it also is a significant cost saving in material and labor needed to fabricate what otherwise would be long and delicate wiring. It is clear from the illustrations of Inoue, Inoue requires longer connecting wiring between his switch 5 and the respective circuits within his card.

Robinson, like Inoue, discloses a switch disposed in the edge of the card, not on the surface. Thus, Robinson does not cure the aforementioned defect of Inoue.

Hafner does not describe a switch.

Iwasaki describes a mechanical slider 5a that moves in a window 5b to open or close a protect tab 5 (col. 1, lines 39- 50). This slider is not an electric switch as is recited in claim 1.

Thus, the cumulative teachings of the prior art references that have been applied against claim 1 would, at best, suggest the use of a slider in the surface of Inoue's card, not an electric

switch, to prevent stored data from being erased. One of ordinary skill in the art, after reading and understanding this prior art, would not be enabled thereby, to make and use the memory card recited in claim 1, having an electric switch located on one of the card surfaces and operable to a state to prevent stored data from being erased. Claim 1 is, therefore, seen to be unobvious; and the rejection of claim 1 should be withdrawn.

Since claims 2-9 depend from claim 1, these dependent claims include all of the limitations recited by the independent claim. Hence, claims 2-9 are unobvious for those reasons that have been discussed above. Furthermore, claim 2 points out that the switch is a slide switch. By locating the slide switch in the surface of the card, the user finds it much easier to operate that switch than if it would be located in the edge, as in Inoue.

Claim 10 does not limit the location of the switch to the surface of the card body. However, claim 10 states that the control circuit in the memory card is responsive to a "read status instruction signal from said external device to supply said status signal to said terminals." This limitation had been recited previously by claim 12, now cancelled. Claim 12 had not been rejected over any prior art references. It follows, therefore, that claim 10 is patentably distinct over the prior art relied upon by the Examiner. Since claims 11 and 13-17 depend from claim 10, these dependent claims likewise are patentably distinct and are in condition for allowance.

Claims 1-8 and 10-16 were further rejected for obviousness-type double patenting in view of claims 1, 3 and 5-9 of U.S. Patent 6,170,743. Reconsideration and withdrawal of this double patenting rejection is respectfully solicited.

A comparison of claim 1 of the present application and claim 1 of the '743 patent indicates that the following claimed elements find no correspondence in the patent claim of '743:

"a substantially rectangular card body..."

“terminals provided in the vicinity of one of the edges... and on one of said substantially rectangular surfaces...”

No evidence has been found by the Examiner, nor has the Examiner proposed arguments, that would support a finding that the aforequoted elements of claim 1 of the instant application are obvious in view of claim 1 of the '743 patent. Nor is there anything recited in claims 5-9 of the '743 patent that would be suggestive to one of ordinary skill in the art of the aforequoted elements of claim 1 of this application. It follows, then, that claim 1 is unobvious over the claims of the '743 patent; and the rejection of claim 1 for obviousness-type double patenting should be withdrawn.

Claim 10 of the present application recites the very same elements as quoted above in respect of claim 1. These elements are not described in nor suggested by claims 1, 3 and 5-9 of the '743 patent. Therefore, claim 10 is unobvious over the claims of '743; and the rejection of claim 10 for obviousness type double patenting should be withdrawn.

Since claims 1 and 10 are unobvious over the claims of the '743 patent, it follows that claims 2-9 (which depend from claim 1) and claims 11 and 13-17 (which depend from claim 10) also are unobvious. Therefore, the double patenting rejection should be withdrawn.


In view of the foregoing, it is respectfully submitted that claims 1-11 and 13-17, all the claims present in this application, are in condition for allowance. An early notice to this effect is respectfully requested.

Statements appearing above in respect to the disclosures in the cited references represent the present opinions of the undersigned attorney and, in the event the Examiner disagrees with any of such opinions, it is respectfully requested that the Examiner specifically indicate those portions of the references providing the basis for a contrary view.

Please charge any additional fees that may be needed, and credit any
overpayment, to our Deposit Account No. 50-0320.

Respectfully submitted,
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WSF:pd

Version With Markings to Show Changes Made

Amend claims 1, 10 and 13-15 as follows:

-- 1. (Amended) A memory card for storing data written thereto from an external device, comprising:

a substantially rectangular card body having first and second substantially rectangular surfaces and edges between said surfaces;

terminals provided in the vicinity of one of the edges between said surfaces and on one of said substantially rectangular surfaces for inputting data from or outputting data to said external device;

a storage device disposed in said card body for storing said data inputted from said terminals;

an electric [a] switch located on one of said surfaces and operable to a state to prevent the data stored in said storage device from being erased; and

a control circuit electrically connected between said terminals and said storage device for writing data from an external device to said storage device, for reading out stored data to said terminals from said storage device and for supplying to said terminals a status signal representing the state of said switch.

10. (Amended) A memory card for storing data written thereto from an external device, comprising:

a substantially rectangular card body having first and second substantially rectangular surfaces and edges between said surfaces;

terminals provided in the vicinity of one of the edges between said surfaces and on one of said substantially rectangular surfaces for inputting data from or outputting data to said external device;

a storage device disposed in said card body for storing said data inputted from said terminals;

a switch located on one of the edges between said surfaces and operable to a state to prevent the data stored in said storage device from being erased; and

a control circuit electrically connected between said terminals and said storage device for writing data from an external device to said storage device, for reading out stored data to said terminals from said storage device and for supplying to said terminals a status signal representing the state of said switch, said control circuit being responsive to a read status instruction signal from said external device to supply said status signal to said terminals.

13. The memory card of claim [12] 10 wherein said control circuit is responsive to a write instruction signal from said external device to write data to said storage device; and wherein said read status instruction signal precedes said write instruction signal.

14. The memory card of claim [12] 10 wherein said control circuit is responsive to an erase instruction signal from said external device to erase data stored in said storage device; and wherein said read status instruction signal precedes said erase instruction signal.

15. The memory card of claim [12] 10 wherein said data written to said storage device comprise a data file; and wherein said read status instruction signal is supplied prior to writing a data file to or erasing a data file from said storage device. --